

REMARKS

Claims 1-7 and 23-35 are pending. Claims 1-7 and 23-35 have been rejected in the office action of May 25, 2004. New claim 36 has been added.

Paragraphs 3 and 4 of the Office Action

Claims 1,2, 6, 23, 25-27, and 30-35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hart (GB 2205295) in view of James (U.S. Patent 3,360,412) and either one of Rutledge (U.S. Patent 3,245,857) or Kaercher et al. (U.S. Patent 3,905,854). This rejection is respectfully traversed because Hart, James, Rutledge and Kaercher - either alone or in combination - do not provide any teaching, disclosure or suggestion of the combination of limitations set forth under any of the pending claims of the present application.

Hart is specifically directed to a means of reducing the loss of carbon dioxide through a pre-formed polyethylene (PET) bottles holding carbonated drinks (see, *e.g.*, Hart at p. 1) According to the Examiner, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to attached the metal base to the label taught by Hart to the plastic container in any suitable manner such as dry lamination...such that lamination occurs without the use of an intermediate bonding agent.” This assertion is unfounded. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

In the May 25, 2004 Office Action, James is the only reference that the Examiner identifies as describing a dry lamination technique. However, the Examiner has shown no suggestion or incentive that indicates that one of ordinary skill in the art reading Hart would be motivated to apply a dry lamination technique to the processes described in Hart. In fact, there are at least two reasons that indicate that there is no motivation to combine the techniques described in Hart with the techniques described in James in any manner, let alone one that would render the claims of the present application obvious under 35 USD 103(a).

First of all, Hart does not mention of James. Similarly, James does not mention Hart. As a result, one of ordinary skill in the art would not be immediately directed to James upon a reading of Hart or vice versa. Therefore, there is no explicit motivation to combine James with the techniques described in Hart.

Second, as stated in the previous Response, in the preferred embodiment of Hart, a label is secured to a pre-formed polyethylene bottle by a continuous layer of adhesive between the label and the pre-formed polyethylene bottle (Hart at p. 3). Because the expressed preferred embodiment of Hart uses an adhesive layer, one of ordinary skill in the art would be motivated to search for bonding techniques for attaching a label to a preformed container or bonding techniques that use an adhesive layer to couple a label to a preformed container.

However, the lamination processes discussed in James does not disclose any techniques for bonding a label to a preformed container whatsoever - with or without an adhesive layer. Rather, in James, an unformed substrate sheet is secured to an unformed thermoplastic sheet (i.e., not preformed into the shape of a container) through a dry lamination process that requires the feeding of the two sheets through a path where the sheets are passed between a multitude of rollers and through a plurality of severe S-shaped turns (see e.g., Figs. 1-3 of James and associated portions of the specification between 4:23-15:70). James explicitly states that the techniques described therein are for use of rolls and/or sheets of material that are of a flat configuration (see James specification 15:55-61) not for an injection blow moulded bottle as described in Hart. As a result, there is no suggestion or teaching in James for applying its techniques to the bottle/label applications described in Hart.

Thus, at least these two reasons, there is no basis for applying the techniques described in James with the teachings described in Hart. Therefore, there is no motivation to combine Hart with James. As a result, the claims of the present application cannot be considered obvious under 35 USC 103(a) in view of these two references.

Combining the teachings of Hart in view of James with either Rutledge and Kaercher fails to provide any further reasons for supporting the Examiner's assertions of obviousness. Hart does not contain any mention of Rutledge or vice versa. Hart also does not contain any mention of Kaercher or vice versa. Similarly, James contains no mention of Rutledge or Kaercher (or vice versa). As a result, one of ordinary skill in the art would not be immediately directed to Rutledge, and/or Kaercher upon a reading of Hart and/or James.

Further more, Rutledge and Kaercher deal with technology that is non-analogous to the techniques described in Hart, the techniques described in James, and the methods recited in the claims of the present application. As a result, there is no motivation to combine Rutledge or Kaercher with either Hart and/or James in any manner that would render that claims of the present application obvious under 35 USC 103(a).

Specifically, neither Rutledge or Kaercher describe a process for coupling a metallic layer with a pre-formed semi-permeable container having a polymeric external surface in a manner recited in any of the claims of the present application.

Rutledge is directed to attaching labels to a glass bottle (specifically beer bottles in the preferred embodiment – see Rutledge 1:68-70) by melting a wax layer of the label (see e.g., Rutledge 4:24-37). Nothing in Rutledge is directed to adhering a label to a plastic bottle as described in Hart or a dry lamination process for adhering a substrate sheet with a plastic sheet as described in James. Furthermore, nothing in Rutledge is directed to adhering a label to a pre-formed semi-permeable containers as recited in the claims of the present application.. The glass bottle described in Rutledge cannot be deformed like a pre-formed semi-permeable container having a polymeric external surface and, therefore, the techniques in Rutledge do not have to deal with the same problems as encountered in the methods recited in the claims of the present application.

Kaercher is directed to attaching labels to a glass bottle (specifically beer bottles in the preferred embodiment – see Kaercher 1:5-8, 5:17-21) by heating a quick-tack hot-melt

polymer (see e.g., Kaercher 6:22-27). Similar to Rutledge, nothing in Kaercher is directed to adhering a label to a plastic bottle as described in Hart or a dry lamination process for adhering a substrate sheet with a plastic sheet as described in James. Furthermore, nothing in Kaercher is directed to adhering a label to a pre-formed semi-permeable containers as recited in the claims of the present application.. The metal can described in Kaercher does not encounter the same deformation concerns of a plastic bottle (as described in Hart) or a pre-formed semi-permeable container having a polymeric external surface and, therefore, the techniques in Kaercher do not have to deal with the same problems as encountered in the methods recited in the claims of the present application.

In summary, there is no motivation for one of ordinary skill in the art to combine the disclosure of Hart with the disclosure of James and Rutledge or Kaercher because:

1. There is no mention of James, Rutledge or Kaercher in Hart;
2. The preferred adhesion process for adhering a metallic label to a bottle under Hart requires an adhesive coating between the metallic label and the bottle. In contrast, the lamination processes discussed in James do not involve an adhesive coating;
3. Hart requires an adhesion process that can be used on a bottle while James is directed to fusing an unformed plastic sheet or “films” to a unformed substrate sheet between using a roll press with a plurality of rollers through which the plastic and substrate sheets are tortuously threaded through a path with multiple sharp S-shaped turns that prevent use of its teachings to applications such as those described in Hart or those recited in the claims of the present application;
4. Kaercher is directed to adhesion of a label to a glass bottle which is completely non-analogous to the attaching of a label to a “moulded” plastic bottle as set forth in Hart and in the claims of the present application; and
5. Kaercher is directed to adhesion of a label to a metallic can which is completely non-analogous to the attaching of a label to a “moulded” plastic bottle as set forth in Hart and in the claims of the present application.

Thus, for at least the reasons set forth above there is no motivation to combine Hart with the techniques described in James, Rutledge, Kaercher in any manner, let alone a manner that would

render the claims of the present application obvious. Without establishing a motivation to combine Hart with James and Rutledge or Kaercher, there can be no finding of obviousness using these references. As a result, claims 1,2, 6, 23, 25-27, and 30-35 cannot be found obvious under Hart in view James and Rutledge or Kaercher. Therefore, for at least the reasons discussed above, claims 1,2, 6, 23, 25-27, and 30-35 are believed to be patentably distinguishable over Hart in view James and Rutledge or Kaercher. Withdrawal of this rejection is respectfully requested.

Paragraph 5 of the Office Action

Claims 3-5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of the admitted prior art.

Claims 3-5 depend from the currently presented claim 1. Therefore, at least by virtue of their respective dependencies from claim 1, claims 3-5 are also believed to be in condition for allowance.

Paragraph 6 of the Office Action

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Kelch et al. (U.S. Patent 6,042,930).

Claim 7 depends from the currently presented claim 1. Therefore, at least by virtue of its dependency from claim 1, claim 7 is believed to be in condition for allowance.

Paragraph 7 of the Office Action

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Yoda et al. (U.S. Patent 3,961,009).

Claim 24 depends from the currently presented claim 23. Therefore, at least by virtue of its dependency from claim 23, claim 24 is believed to be in condition for allowance.

Paragraph 8 of the Office Action

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Swierczek (U.S. Patent 5,024,014).

Claims 28 and 29 depend from the currently presented claim 23. Therefore, at least by virtue of their respective dependencies from claim 23, claims 28 and 29 are believed to be in condition for allowance.

If for any reason an insufficient fee has been paid, the Examiner is hereby authorized to charge the insufficiency to Deposit Account No. 05-0150.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney at (650) 843-3215.

Date: August 25, 2004

Squire, Sanders & Dempsey L.L.P.
600 Hansen Way
Palo Alto, CA 94304
Telephone (650) 856-6500
Facsimile (650) 843-8777

Respectfully submitted,

By: V. Bhakar
Vidya R. Bhakar
Attorney for Applicants
Registration No. 42,323